

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of : **Confirmation No. 9646**
Kenji IWANO et al. : Attorney Docket No. 2002_0211A
Serial No.10/067,843 : Group Art Unit 3626
Filed February 8, 2002 : Examiner Dilek B. Cobanoglu
MEDICAL INFORMATION SYSTEM : **Mail Stop: Reply Brief-PATENT**

REPLY APPEAL BRIEF FILED UNDER 37 CFR §41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is Appellant's Reply Brief, in response to the Examiner's Answer mailed on November 10, 2009, submitted under the provisions of 37 CFR § 41.41.

REAL PARTY IN INTEREST

The real party in interest is Panasonic Corporation of Osaka, Japan, the assignee of record (reel/frame 021897/0624).

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

Claim 2 is cancelled. Claims 1 and 3-17 are rejected. In a final Office Action of dated March 6, 2009, the Examiner rejected pending claims 1 and 3-17 in view of the prior art. The rejection of claims 1 and 3-17 is being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final Office Action dated March 6, 2009. All previously filed amendments have been entered by the Examiner.

RESPONSE TO EXAMINER'S ANSWER

Claims 1 and 3-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Joao (U.S. 6,283,761), Califano et al. (U.S. 2003/0039362) and Felsher (U.S. 2002/0010679). An Examiner's Answer was mailed on November 10, 2009 addressing portions of the arguments presented in the Appeal Brief filed on August 10, 2009.

Specifically, on pages 12-19 of the Examiner's Answer, the Examiner provides a response to the following arguments presented in the Appeal Brief filed on August 10, 2009:

(A) The combination of Joao and Califano fails to disclose or suggest that the patient server manages the vital information and unique identifications, such that the correspondence between each of the unique identifications and patient data (including at least a patient name) is unrecognizable;

(B) The combination of Joao and Califano fails to disclose or suggest that the medical care provider server is connected to the patient server through the first network, such that the medical care provider server makes the vital data, unique identifications, and corresponding patient data (patient name) available;

(C) The combination of Joao and Califano fails to disclose or suggest disallowing communication between the patient or doctor terminal and either the patient server or the medical care provider server; and

(D) Felsher teaches away from the invention of Joao, since Felsher describes a medical security system including a database 6 that maintains patient medical history records separate from corresponding patient identification information contained in the index server 5.

Below, Applicants provide a reply to the Examiner's position set forth on pages 12-19 of the Examiner's Answer regarding above-mentioned arguments (A)-(D). Initially, Applicants submit that the arguments presented below are not intended to replace or supersede the arguments presented in the Appeal Brief filed on August 10, 2009, but rather are only presented to provide a direct response to the position set forth in the Examiner's Answer.

Argument A

Regarding Argument (A) addressed on pages 13-16 of the Examiner's Answer, Applicants note that page 15 of the Examiner's Answer indicates that Califano discloses that

“[i]n one practice the VPI may comprise a random number, or some other type of identifier that lacks any information that may be employed, in and of itself, to determine identify information, such as name or social security number of the participant assigned the respective VPI” (see paragraph [0010] of Califano).

However, Applicants note that immediately after the above-mentioned disclosure of Califano in paragraph [0010], Califano teaches creating an encrypted database that contains a pairing between the patient identity information and the VPI (including the random number or some other type of identifier). In other words, the patient identity information and the VPI (masking the identity information) are paired and stored in the same encrypted database.

As a result, after considering the above-mentioned additional disclosures of Califano as a whole, it is evident that Califano teaches that the patient identify information and the VPI are paired and stored in the same database. Thus, in view of the above, it is clear that Califano fails to disclose or suggest that the patient server manages the vital information and unique identifications, such that the correspondence between each of the unique identifications and patient data (including at least a patient name) is unrecognizable, as required by claim 1.

In other words, Califano teaches that the patient's name is stored in association with the VPI related to the unique identifier of the patient in an encrypted database, which makes it possible to obtain the relationship between the patient's name and the patients unique identifier by applying a decryption key to the VPI. On the other hand, claim 1 requires the correspondence between each of the unique identifications and patient data (including at least a patient name) to be unrecognizable.

This feature of the correspondence between the unique identifications and the patient data being unrecognizable is described in paragraph [0075] of the specification of the present

invention, which states “although the patient server 1 stores the vital data for each of the ID’s, the patient server 1 does not store the patient data corresponding to each of the IDs.

Accordingly, if the patient server 1 were accessed without authorization, it would be impossible to identify each of the vital data of a particular patient.”

Therefore, since according to Califano the relationship between the patient’s name and the patient’s ID can be accessed using decryption (i.e., is recognizable), Califano cannot be relied upon for disclosing or suggesting that from the patient server the correspondence between each of the unique identifications and patient data (including at least a patient name) is unrecognizable (i.e., impossible to identify), as required by claim 1.

Arguments B and C

Regarding Arguments (B) and C addressed on pages 16-18 of the Examiner’s Answer, Applicants note that the Examiner’s Answer relies on col. 13, lines 52-65, col. 14, lines 59-64, and col. 16, lines 38-65 of Joao for teaching that the medical care provider server is connected to the patient server through the first network, such that the medical care provider server makes the vital data, unique identifications, and corresponding patient data (patient name) available, and disallowing communication between the patient or doctor terminal and either the patient server or the medical care provider server, as recited in claim 1.

However, the above-mentioned portions of Joao merely teach determining whether or not a connection between computers 10, 20, 30, 40 and 50 is established, and whether or not the type of data exchanged between the computers is limited.

Thus, in view of the above, even though Joao teaches determining whether or not connections can be made and what type of data can be made between various computers, Joao still fails to disclose or suggest the specific structure required by claim 1, such that the medical

care provider server is connected to the patient server through the first network, and such that the medical care provider server makes the vital data, unique identifications, and corresponding patient data (patient name) available, and disallowing communication between the patient or doctor terminal and either the patient server or the medical care provider server.

In other words, Joao's broad disclosure of connecting computers and limiting the type of data transferred therebetween fails to disclose or suggest that the medical care provider server is connected to the patient server through the first network, and that the medical care provider server makes the vital data, unique identifications, and corresponding patient data (patient name) available, and disallowing communication between the patient or doctor terminal and either the patient server or the medical care provider server, as recited in claim 1.

Applicants would like to stress that even though Joao teaches connecting and transferring data between various computers, Joao does not disclose or suggest the specific structure between the medical care provider server, the patient server and the first network, as required by claim 1.

Argument D

Regarding Argument (D) addressed on pages 18 and 19 of the Examiner's Answer, Applicants note that the Examiner's Answer states that "the motivation to combine these references would be to provide a secure system for exchanging confidential information."

However, Applicants would like to point out that the Appeal Brief makes no comment on the motivation to combine the references, but rather presents arguments regarding the fact that the combination of Felsher (secondary reference) with Joao (primary reference) would change the principle operation of Joao (primary reference) and/or render Joao (primary reference) inoperable for its intended purpose.

Specifically, Applicants would like to emphasize the difference between a motivation to combine a primary and secondary reference, and changing the principle operation of the primary reference and/or rendering the primary reference inoperable for its intended purpose by combining the secondary reference with the primary reference.

In view of the above, Applicants submit that Felsher clearly describes a medical security system including a database 6 that maintains patient medical history records separate from corresponding patient identification information contained in the index server 5. By virtue of maintaining the database 6 separate from the index server 5, Felsher teaches against associating patient medical records with the corresponding unique identification, as required by Joao.

Moreover, because Felsher does not also employ a system that maintains patient medical history that is associated with corresponding unique identification information in a same database, it is incompatible with Joao. Substituting the medical security system of Felsher for the health care information system of Joao, renders the system of Joao unsatisfactory for its intended purpose, because, by combining the medical system of Felsher with the system of Joao, a user cannot access a patient's medical history and/or other information that can be relevant and/or pertinent using corresponding unique identifications. Because the proposed modification/substitution changes the principle of operation of Joao and renders Joao unsatisfactory for its intended purpose, Felsher is incompatible with Joao.

As discussed in the Appeal Brief, MPEP § 2145(III) establishes that a claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose, and MPEP § 2145(VI) establishes that a prior art reference must be considered in its entirety.

In view of the above, the Applicants respectfully submit that, although Felsher is in the same field of endeavor as Joao, the Examiner has not considered Felsher in its entirety. Specifically, it does not appear that the Examiner has considered that maintaining the database separate from the index server 5, teaches against associating patient medical records with the corresponding unique identification, as required by Joao. Thus, as discussed above, when Felsher is considered in its entirety, the structure required by Felsher teaches away from the structure required by Joao, because the structure required by Felsher would change the principle of operation of Joao and render Joao inoperable for its intended purpose. Therefore, even if one would be motivated to combine the features of Joao and Felsher to solve a known problem, Applicants submit that the data structures required by Joao and Felsher are incompatible with each other for the reasons discussed above.

Conclusion

Therefore, because of the above-mentioned distinctions it is believed clear that claim 1 and claims 3-7 that depend therefrom would not have been obvious or result from any combination of Joao, Califano and Felsher.

Independent claim 8 recites the same distinguishing limitations discussed above regarding claim 1. Therefore, independent claim 8 and claims 10-13 that depend therefrom are patentable over the Joao, Califano and Felsher references for reasons similar to those set forth above regarding claim 1.

Independent claim 9 recites the same distinguishing limitations discussed above regarding claim 1. Therefore, independent claim 9 and claims 14-17 that depend therefrom are patentable over the combination of Joao, Califano and Felsher for reasons similar to those set forth above regarding claim 1.

In view of the above, it is respectfully submitted that independent claims 1, 8 and 9 and claims 3-7, 10-13 and 14-17 which depend therefrom would not have been obvious or result from any combination of Joao, Califano and Felsher. Furthermore, there is no disclosure or suggestion in Joao, Califano and/or Felsher or elsewhere in the prior art of record which would have caused a person of ordinary skill in the art to modify Joao, Califano and/or Felsher to obtain the invention of independent claim 1, 8 and 9. Accordingly, the Examiner's decision to finally rejection claims 1 and 2-17 should be reversed.

Respectfully submitted,

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